



8-19-03

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1634

Docket No. 55293-A/JPW/AJM/MVM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Carlos Cordon-Cardo et al.

Serial No.: 09/329,917

Examiner: J. Souaya

Filed : June 10, 1999

Group Art Unit: 1634

For : MARKERS FOR PROSTATE CANCER

Date of Notice

of Allowance: July 23, 2002

Confirmation No.: 8767

Issue Fee Paid: October 23, 2002

1185 Avenue of the Americas
New York, New York 10036
May 14, 2003

Office of Petitions
Commissioner for Patents
Crystal Plaza 4
Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

ATTN: Wan Laymon

Sir:

**REQUEST FOR RECONSIDERATION OF
MARCH 17, 2003 DECISION ON PETITION PURSUANT
TO 37 C.F.R. §1.137(e) AND CONTINGENT PETITION
FOR WITHDRAWAL FROM ISSUE UNDER 37 C.F.R. §1.313(c) (2)**

Applicants hereby request reconsideration pursuant to 37 C.F.R. §1.137(e) of a March 17, 2003 Decision on Petition which was issued by Mr. Tom Hawkins of the Office of Patent Publication at the United States Patent and Trademark Office ("USPTO") in connection with the above-identified application. 37 C.F.R. §1.137(e) provides a period of two months for filing a Request for Reconsideration. Therefore, a Request is due by May 17, 2003. Accordingly, this Request is being timely filed.

On December 9, 2002, a Notice of Abandonment was issued by the USPTO for failure to timely file formal drawings as required by a July 23, 2002 Notice of Allowability issued in connection with the subject application. In response, on January 28, 2003,

Applicants: Carlos Cordon-Cardo et al.
Serial No.: 09/329,917
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Page 2

applicants timely filed a Petition Under 37 C.F.R. §1.181 To Withdraw Holding Of Abandonment, which included (i) a copy of applicants' October 23, 2002 Communication Forwarding Formal Drawings having attached thereto twelve sheets of new, corrected formal drawings, (ii) a copy of a certificate of mailing signed and dated October 23, 2002 and (iii) a copy of a postcard bearing the stamp of the USPTO confirming receipt of the Communication on October 29, 2002. The October 23, 2002 Communication was timely filed in that it was filed concurrently with payment of the issue fee.

In a February 28, 2003 telephone conference between Ms. Christina Connell of the Office of Petitions at the USPTO and Maria Marucci, Esq. of the undersigned attorneys' office, Ms. Connell stated that according to her records, the January 28, 2003 Petition was not received by the USPTO. Accordingly, on February 28, 2003, applicants submitted a Communication Forwarding Copy of January 28, 2003 Petition To Withdraw Holding Of Abandonment And Contingent Petition For Withdrawal From Issue Under 37 C.F.R. §1.313(c) (2) to the Office of Petitions.

In the March 17, 2003 Decision, the USPTO acknowledges receipt by first class mail on October 29, 2002 of the Communication Forwarding Formal Drawings, including twelve sheets of drawings attached thereto and a certificate of mailing signed and dated October 23, 2002 (37 C.F.R. §1.8). However, the Decision states that the October 23, 2002 Petition is dismissed because applicants allegedly did not respond to the Examiner's Amendment which accompanied the Notice of Allowability mailed by the USPTO on July 23, 2002. Therefore, the Decision states that the application was properly abandoned and the holding of abandonment will not be withdrawn at this time.

In response, applicants attach hereto as **Exhibit I** a copy of an

Applicants: Carlos Cordon-Cardo et al.
Serial No.: 09/329,917
Filed : June 10, 1999
Page 3

Amendment After Notice of Allowance Pursuant To 37 C.F.R. §1.312 which applicants timely submitted to the USPTO on October 23, 2002 (which includes substitute pages 7-14 of the specification as Exhibit A and a marked-up version of substitute pages 7-14 of the specification as Exhibit B and a signed first class certificate of mailing dated October 23, 2002). As additional evidence of applicants' timely submission of the Amendment on October 23, 2002, applicants attach hereto as **Exhibit II** a copy of a postcard bearing the stamp of the USPTO confirming receipt of the Amendment on October 29, 2002.

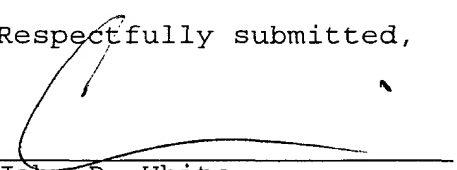
Contingent upon the positive disposition of applicants' Request for Reconsideration, applicants attach hereto as **Exhibit III** a copy of a Petition to Withdraw from Issue Under 37 C.F.R. §1.313(c)(2) which applicants submitted to the USPTO on February 28, 2003 in connection with the subject application. In the Petition, applicants request that the subject application be withdrawn from issue under 37 C.F.R. §1.313(c)(2) in consideration of a February 28, 2003 Request for Continued Examination ("RCE") in compliance with 37 C.F.R. §1.114, a copy of which applicants enclose herewith, so that references not previously of record which are set forth in a February 28, 2003 Supplemental Information Disclosure Statement, a copy of which is also enclosed herewith, may be considered by the Patent Office.

In view of the above facts, applicants respectfully request that (a) this Request for Reconsideration be considered, (b) the holding of abandonment be withdrawn, (c) the attached February 28, 2003 Petition to Withdraw from Issue be considered and the subject application be withdrawn from issuance, (d) the February 28, 2003 RCE be accepted and (e) the February 28, 2003 Supplemental Information Disclosure Statement be considered by the Patent Office.

Applicants: Carlos Cordon-Cardo et al.
Serial No.: 09/329,917
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Page 4

No fee is deemed necessary in connection with the filing of this Request. Applicants note that they submitted a check in the amount of \$505.00 on February 28, 2003, which included the \$130.00 fee for the Petition to Withdraw from Issue and the \$375.00 RCE filing fee. If any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Carlos Cordon-Cardo et al.
Serial No.: 09/329,917 Examiner: J. Souaya
Filed : June 10, 1999 Group Art Unit: 1634
For : MARKERS FOR PROSTATE CANCER
Date of Notice
of Allowance: July 23, 2002 Confirmation No.: 8767
Issue Fee Paid: October 23, 2002

1185 Avenue of the Americas
New York, New York 10036
February 28, 2003.

Assistant Commissioner for Patents
Washington, D.C. 20231

Attention: Office of Petitions

Sir:

**PETITION FOR WITHDRAWAL FROM ISSUE
UNDER 37 C.F.R. §1.313(c)(2)**

Applicants hereby petition that U.S. Serial No. 09/329,917 in which the issue fee was paid on October 23, 2002, be withdrawn from issue under 37 C.F.R. §1.313(c)(2) in consideration of a Request for Continued Examination ("RCE") in compliance with 37 C.F.R. §1.114 which applicants enclose herewith so that references not previously of record which are set forth in a Supplemental Information Disclosure Statement, also enclosed herewith, may be considered by the Patent Office.

The required petition fee set forth in 37 C.F.R. §1.17(h) is ONE HUNDRED THIRTY DOLLARS (\$130.00) and a check including this amount is enclosed.

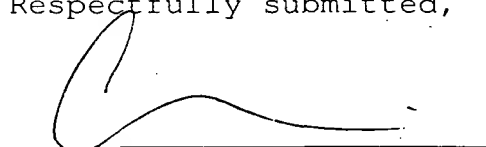
Applicants are petitioning that the subject application be withdrawn from issue so that references submitted in the

Applicants: Carlos Cordon-Cardo et al.
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Page 2

enclosed Supplemental Information Disclosure Statement for consideration may be considered by the Patent Office. Applicants do not believe that the references affect the patentability of the subject matter claimed in the subject application. However, in accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants are requesting that the references be considered by the Patent Office.

No fee, other than the enclosed \$130.00 petition fee, is deemed necessary in connection with the filing of this Petition. However, if an additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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Application No. 09/329,917
Filing Date June 10, 1999
Inventor(s) Carlos Cordon-Cardo
et al.
Group Art Unit 1634
Examiner Name J. Souaya
Attorney Docket No. 1747/55293-
A/JPW/AJM/MVM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

February 28, 2003

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Sir:

This is a Request for Continued Examination under 37 C.F.R. § 1.114 of the above-identified application.

1. ☐ Consider the unentered amendment/reply under 37 C.F.R. § 1.116 previously filed on _____.
2. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____.
3. ☒ Enclosed is/are
☐ Amendment/Reply.
☐ Affidavit(s)/Declaration(s).
☒ Information Disclosure Statement (IDS).
☒ PTO-1449
☒ Copy of IDS Citation
☐ Other: _____
4. ☒ Small entity status under 37 C.F.R. § 1.27 is claimed.
☐ A verified statement to establish small entity status is enclosed.
☒ A verified statement to establish small entity status was previously filed and such status is still proper and desired.
5. ☒ A check in the amount of \$ 375.00 is enclosed.

6. X The Commissioner is hereby authorized to charge the following fees, or credit any overpayment, to Deposit Account No. 03-3125.

 X RCE fee required under 37 C.F.R. § 1.17(e).

 X Extension of time fee (37 C.F.R. §§ 1.136 and 1.17).

 Other fees _____.

7. X Three copies of this sheet are enclosed.

Respectfully submitted,



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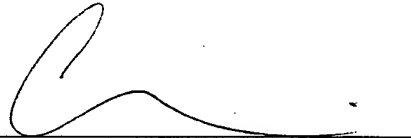
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